UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,745	02/15/2001	James A. Ream	00-40225-US	2176

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EXAMINER
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ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/783,745	REAM ET AL.
	Examiner	Art Unit	
	Angel L. Casiano	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _15 February 2001_.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-87_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-13, 16-23, 25-30, 35-53, 62-66, 68-71, 74-79, 82 and 84-87_ is/are rejected.
7) ☒ Claim(s) _14, 15, 24, 31-34, 46, 54-61, 67, 72, 73, 80, 81 and 83_ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _15 February 2001_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _20031114_.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The present Office action is in response to application dated 15 February 2001.

Claims 1-87 are pending. All claims have been examined.

Information Disclosure Statement

1.   The information disclosure statement (IDS) submitted on 14 November 2003 was filed after the mailing date of the application on 15 February 2001. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

-      Figure 10, elements "1002", "1004", "1006", "1008".

-      Figures 11A and 11B (Specification refers to Figure 11 only).

-      Figure 11B, steps "1124" and "1130".

-      Figure 12, steps "1208" and "1210".

-      Figure 14, element "1426".

Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing

on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description:

- Figure 11B, step "1132" cited on Page 23, line 10 of the Specification.

- Figure 13, element "1304" cited on Page 25, line 17 of the Specification.

- Figure 14, elements "1412" (cited on Page 27, line 13) and "1414" (cited on Page 28, line 3).

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4.   The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

5.   Claims 31 and 32 are objected to because of the following informalities: The cited claims recite a "defined list of parameters" in reference to claim 29. However, these claims should read "*pre*-defined list of parameters", in order to be consistent with the independent claim. Appropriate correction is required.

6.   Claims 14-15, 24, 31-34, 54-61, 67, 72-73, 80-81, and 83 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7.   Claim 46 mentions a "process". However, independent claims refer to a "method" (see claims 47-61). Appropriate correction is required.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9.   Claims 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10.   Claim 21 recites "writeable removable memory drive" in reference to claim 16. However, claim 16 does not mention such memory. In another aspect of the claim, it cites "build generating station". Nonetheless, claim 16 recites, "build *generator*" and "build *server*". There is insufficient antecedent basis for this limitation in the claim.

11.   Claim 22 recites the limitation "build generating station" in reference to claim 16. However, claim 16 discloses a "build *generator*" as part of a system, as well as a "build *server*". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13.   Claims 1-6, 8, 11-12, 16-17, 21-23, 35-37, 42, 44-47, 74, 76, and 84-87 are rejected under 35 U.S.C. 102(e) as being anticipated by Halpern et al. [US 6,282,711 B1].

Regarding claim 1, Halpern et al. teaches a vendor provided installation program (see Abstract) for installing a specific software package (see column 3, lines 1-2) onto a computer; and a generating station (see Figure 2, "102"), said station having generating software for generating a

plan (see column 3, lines 42-44, 62-67; column 4, lines 44-53) which, when executed on a recipient computer, causes software to be installed on the recipient computer (see "client") utilizing the at least one installation program, wherein it is accessible to recipient computers via a network (see column 3, line 1).

As for claim 2, Halpern et al. explicitly teaches a system for installing software onto a recipient computer according to claim 1, wherein the network is the Internet (see Abstract).

As per claim 3, Halpern et al. cites transfer means for transferring a plan to a recipient computer (see column 7, lines 57-67).

As per claim 4, Halpern et al. teaches a transfer device associated with the generating station (see "storage medium", column 8, lines 14-15).

As for claim 5, Halpern et al. teaches a writeable removable memory unit (see column 8, lines 14-16).

As for claim 6, Halpern et al. teaches the use of a floppy disk (see column 8, line 16).

As per claim 8, Halpern et al. teaches a network interface (see Figure 1).

As for claim 11, Halpern et al. teaches a program installation command, causing a computer program to be installed onto a recipient computer according to parameters stored in a software installation data package (see column 4, lines 47-50).

As per claim 12, Halpern et al. teaches an indication that the recipient computer should initialize upon completion of the computed program associated with the software installation package (see column 6, lines 47-52).

Regarding claim 16, Halpern et al. teaches a system (see Abstract) for installing a specific software package (see column 3, lines 1-2) onto a recipient computer; and a generating station (see Figure 2, "102"), the station having generating software for generating a plan (see column 3, lines 42-44, 62-67; column 4, lines 44-53) which, when executed on a recipient computer, causes software to be installed on the recipient computer (see "client") utilizing the at least one installation program, wherein it is accessible to recipient computers via a network (see column 3, line 1). In addition, Halpern et al. teaches a network interface (see Figure 1).

As per claim 17, Halpern et al. teaches an "input device" (see Figure 1, "106") for information, which identifies installable software to be installed on a recipient computer (see "dialogue", column 5, lines 6-7; "software", Abstract).

As for claim 21, Halpern et al. teaches a "remote server" (see Abstract).

As per claim 22, Halpern et al. discloses a single computer (see "remote server" 102) for generating installation software.

As for claim 23, Halpern et al. explicitly teaches a database containing package definitions for software installation onto a recipient computer (see "database", Figure 1, "108"; column 5, lines 20-25).

Regarding claims 35-37, 42, 44-45 these constitute a variation of the system for installing software onto recipient computers. The prior art cited in this reference teaches the limitations for this system. Accordingly, these claims are rejected under the same basis.

Regarding claims 46-47, these constitute the method for the system for installing software onto recipient computers. The prior art cited in this reference teaches the limitations for this system. Accordingly, these claims are rejected under the same basis.

Regarding claims 74, 76 and 84-87, these constitute the build plan for the system for installing software onto recipient computers. The prior art cited in this reference teaches the limitations for this system. Accordingly, these claims are rejected under the same basis.

14.   Claims 7, 13, 18-20, 38-41, 43, 62-63, 65-66, 68, and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern et al. [US 6,282,711 B1].

As per claim 7, Halpern et al. teaches writeable removable media (see column 8, lines 14-19). However, the cited prior art does not specify the removable media as a compact disk. Nonetheless, the reference suggests types of transfer devices, including "floppy diskettes" as example (see claim 6). Compact disks are well known types of writeable removable media. Accordingly, one of ordinary skill in the art would have been motivated to specify the transfer device as a CD, since it is a *medium type of limited storage space* (see column 8, lines 14-15).

As for claim 13, Halpern et al. does not explicitly teach a package having "a data field for identifying a text file", this text file for "identifying data required to be provided to a software installation program in response to queries", as claimed. Nonetheless, it does teach an installation package having additional files, as a "batch installation script". Therefore, one of ordinary skill in the art would have been motivated to specify the file as "text", since Halpern et al. explicitly suggests the addition of different files for "enhancing" the prior art package.

As for claim 18, Halpern et al. teaches an input device (see claim 17). However, the cited reference does not explicitly include a "monitor" and "keyboard" as "connected to the build generator", as claimed. However, the cited reference teaches computers. It is well known in the art that monitors and keyboards are examples of input devices.

As for claim 19, Halpern et al. does not explicitly cite an "Internet appliance". Nonetheless, it does explicitly teach a "component pool" in the Internet (see Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, that an Internet

appliance would have been needed in order to implement the prior art system in a "distributed processing network, such as the Internet" (see Abstract).

As for claim 20, Halpern et al. teaches a transfer device associated with the generating station (see "storage medium", column 8, lines 14-15). Halpern et al. also teaches a writeable removable memory unit (see column 8, lines 14-16).

As per claims 38-41, 43 these constitute a variation of the system for installing software onto recipient computers. The prior art cited in this reference teaches or suggests the limitations for this system. Accordingly, these claims are rejected under the same rationale.

As per claims 62-63, 65-66, and 68, these constitute the computer readable medium for the system for installing software onto recipient computers. The prior art cited in this reference teaches or suggests the limitations for this system. Accordingly, these claims are rejected under the same rationale.

As for claim 82, this constitutes the build plan for the system for installing software onto recipient computers. The prior art cited in this reference teaches or suggests the limitations for this system. Accordingly, this claim is rejected under the same rationale.

15.   Claims 9-10, 48, 64, and 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern et al. [US 6,282,711 B1] in view of Ricart et al. [US 2002/0165906 A1].

As for claims 9 and 10, Halpern et al. does not explicitly teach a plan, which when executed on a recipient computer, causes a *security feature* to be provided. Furthermore, the reference fails to teach a certification file. Regarding these limitations, Ricart et al. teaches a system where a security feature (see Page 1, [0006]) is provided. The reference also teaches a certificate. One of ordinary skill in the art would have been motivated to combine the cited disclosures in order to "personalize" a recipient computer (see Ricart et al.) by adding files. The cited combination of references would also provide functioning according to user's particular preferences.

As per claim 48, this constitutes the method for the system for installing software onto recipient computers. The prior art cited in this reference teaches or suggests the limitations for this system. Accordingly, this claim is rejected under the same rationale.

As for claim 64, this constitutes the computer readable medium for the system for installing software onto recipient computers. The prior art cited in this reference teaches the limitations for this system. Accordingly, this claim is rejected under the same rationale.

As per claims 77-79, these constitute the build plan for the system for installing software onto recipient computers. The prior art cited in this reference teaches or suggests the limitations for this system. Accordingly, these claims are rejected under the same rationale.

16.   Claim 25, 27-30, 49-53, 69-71, and 75 rejected under 35 U.S.C. 103(a) as being

unpatentable over Halpern et al. [US 6,282,711 B1] in view of Berman et al. [US 6,502,194 B1].

As for claim 25, Halpern et al. does not teach an executable file as "being executed *automatically*

upon start-up of a recipient computer".   Regarding this limitation, Berman et al. teaches

"executable instructions" being "automatically executed" (see column 6, lines 14-16) when

power is applied.   Accordingly, one of ordinary skill in the art would have been motivated to

modify the disclosure by Halpern et al. in order to provide executable instructions "with no need

to access" additional devices or operating system (see Berman et al.).

As per claim 27, Halpern et al. does not explicitly cites information for "identifying the recipient

computer for a network", as claimed.   Nonetheless, it does teach a package that contains

information that was only *required* for the user's *unique* installation requirements (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention that the

cited prior art identified the recipient computer in order to deliver the "installation package"

found in the reference, which is "unique", as cited above.

As per claim 28, Halpern et al. teaches identification a communication path.   The cited

"package" is transmitted via a communication path (see Figures 2 and 3).

As per claim 29, Halpern et al. teaches a program installation instruction, causing a computer

program to be installed onto a recipient computer according to parameters stored in a software

installation data package (see column 4, lines 47-50). However, Halpern et al. does not teach a command indicating that the recipient computer should be restarted upon completion of execution of an installation program, as claimed. Regarding this limitation, Berman et al. teaches "executable instructions" (commands) being "automatically executed" (see column 6, lines 14-16) when power is applied. One of ordinary skill in the art would have been motivated to modify the disclosure by Halpern et al. in order to provide executable instructions "with no need to access" additional devices or operating system (see Berman et al.).

As per claim 30, Halpern et al. does not explicitly teach a package having "a value identifying a text file", this text file for "including responses required during an installation of a software package", as claimed. Nonetheless, it does teach an installation package having additional files, as a "batch installation script". Therefore, one of ordinary skill in the art would have been motivated to specify the file as "text", since Halpern et al. explicitly suggests the addition of different files for "enhancing" the prior art package.

As for claims 49-53, these constitute the method for the system for installing software onto recipient computers. The prior art cited in this reference teaches or suggests the limitations for this system. Accordingly, these claims are rejected under the same rationale.

As for claims 69-71, these constitute the computer readable medium for the system previously rejected. These claims are rejected under the same rationale.

As per claim 75, this constitutes the build plan for the system previously rejected. This claim is rejected under the same rationale.

17.   Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern et al. [US 6,282,711 B1] in view of Berman et al. [US 6,502,194 B1] in further view of Ricart et al. [US 2002/0165906 A1].

As for claim 26, the combination of references (Halpern et al. in view of Berman et al.) does not teach a *security feature* to be provided to a recipient computer. Regarding this limitation, Ricart et al. teaches a system where a security feature (see Page 1, [0006]) is provided. One of ordinary skill in the art would have been motivated to modify the cited combination of disclosures in order to "personalize" a recipient computer (see Ricart et al.) by adding files. The cited combination of references would also provide functioning according to user's particular preferences.

Conclusion

18.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

-   Slivka et al. [US 2003/0195949 A1] teaches method and systems for obtaining computer software via a network.

-   Narin et al. [US 6,718,549 B1] teaches methods for managing the distribution of client bits to client computers.
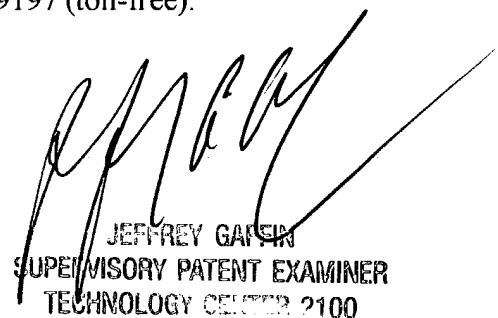
- Teng et al. [US 6,094,679] teaches distribution of software in a computer network environment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L. Casiano whose telephone number is 703-305-8301. The examiner can normally be reached on 9:30-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

alc
07 July 2004

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